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Part III—Section 2

Statutory Notifications and Orders issued by
Heads of Departments.

NOTIFICATIONS BY HEADS OF DEPARTMENTS, ETC.

CONTENTS

Pages.

JUDICIAL NOTIFICATION

The High Court of Judicature at Madras

Madras High Court Intellectual Property Rights Division Rules, 2022 .. 70-77

NOTIFICATIONS BY HEADS OF DEPARTMENTS, ETC.

JUDICIAL NOTIFICATION

THE HIGH COURT OF JUDICATURE AT MADRAS

Madras High Court Intellectual Property Rights Division Rules, 2022

[R.O.C. No. 5906 A/2022 (Comm. Cases)]

No. SRO C-6/2023.

Pursuant to enactment of the *Tribunal Reforms Act, 2021* ("Said Act") on 13.8.2021, the Intellectual Property Appellate Board and some other tribunals were abolished under Sec.33 of the said Act and consequently, the proceedings hitherto pending and filed before such tribunals were transferred to the High Courts under various provisions of the said Act.

Further, the High Court of Madras constituted the Intellectual Property committee to formulate the procedures, consequent thereto.

Upon the recommendation of the Committee, Madras High Court has created the Intellectual Property Division (hereinafter referred to as "the *IPD*") in the High Court to deal with matters relating to Intellectual Property Rights ("*IPR*").

In exercise of the powers conferred by Section 129 of the Code of Civil Procedure, 1908 and Clauses 37 and 38 of the Letters Patent, 1865 and the powers conferred under the various Intellectual Property statutes as amended by the said Act, the Madras High Court hereby makes the following Rules governing the matters listed before the IP Division with respect to practice and procedure for the exercise of its ordinary original, appellate, criminal and writ jurisdiction.

The Intellectual Property statutes include The Trade Marks Act, 1999; The Copyright Act, 1957; The Patents Act, 1970; The Designs Act, 2000; The Geographical Indications of Goods (Registration and Protection) Act, 1999; The Protection of Plant Varieties and Farmers' Rights Act, 2001; The Semiconductor Integrated Circuits Layout-Design Act, 2000 for the purposes of these Rules.

Rule 1 : These Rules shall be called as 'The Madras High Court Intellectual Property Rights Division Rules, 2022' and shall come into force on such date as the Madras High Court may notify in the Official Gazette.

Rule 2 : In these Rules, unless the context otherwise requires:

(1). "Act(s)" means the Statutes mentioned below, as applicable:

- (i). The Copyright Act, 1957;
- (ii). The Designs Act, 2000;
- (iii). The Geographical Indications of Goods (Registration and Protection) Act, 1999;
- (iv). The Patents Act, 1970;
- (v). The Protection of Plant Varieties and Farmers' Rights Act, 2001;
- (vi). The Semiconductor Integrated Circuits Layout- Design Act 2000;
- (vii). The Trade Marks Act, 1999;
- (viii). The Information Technology Act, 2000.

(2). "**Address for service**" includes the address furnished by an applicant, appellant, complainant, petitioner, respondent including the currently authorized trade mark agent, patent agent or other agent before the IPO and also the legal practitioner, at which service of summons, notices or other processes may be effected;

(3). "**Agent**" includes a trade mark or patent agent as defined under Section 145 of Trade Marks Act, 1999 and Section 125 of the Patents Act, 1970 duly authorized by the party concerned;

(4). "**Appeal**" includes an appeal filed before, or transferred to, the IPD under the following sections of the respective Acts with the following nomenclature:

- (i). Under Section 91 of The Trade Marks Act, 1999 [C.M.A. (TM)];
- (ii). Under Section 72 of The Copyright Act, 1957 [C.M.A.(CR)];
- (iii). Under Section 117A of The Patents Act, 1970 [C.M.A. (PT)];
- (iv). Under Section 31 of The Geographical Indications of Goods (Registration and Protection) Act 1999 [C.M.A.(GI)];
- (v). Under Section 56 of The Protection of Plant Varieties and Farmers' Rights Act, 2001 [C.M.A. (PV)];
- (vi). Under Section 42 of the Semiconductor Integrated Circuits Layout- Design Act, 2000 [C.M.A. (SCD)];
- (vii). Under Sections 36 of the Designs Act, 2000 [C.M.A. (DES)];
- (viii). Under Section 62 of the Information Technology Act, 2000 [C.M.A. (IT)];
- (ix). Under Sec.13(1-A) of the Commercial Courts Act, 2015 from the Commercial Courts as constituted by Sec.3 of Commercial Courts Act,2015[CMA-IPD];
- (x). Under Sec.13(1-A) of the Commercial Courts Act, 2015 from the Commercial Division as constituted by Sec.4 of Commercial Courts Act, 2015[OSA-CAD-IP]

(5). "**Fee**" shall mean the fees prescribed in the Schedule I to these Rules;

(6). "**Form**" shall mean the form prescribed in the Practice Notes to be issued separately by the High Court;

(7). "**Intellectual Property Rights (IPR) Disputes**", for the purpose of these Rules, shall include only proceedings of civil nature:

- (i). pertaining to Patents, Copyrights, Trademarks, Geographical Indications, Plant Varieties, Designs, Semiconductor integrated circuit layout-designs, Traditional Knowledge and all rights under common law, if any, associated therewith;
- (ii). relating to passing off, acts of unfair competition, disparagement, comparative advertising etc.;
- (iii). relating to protection of trade secrets, confidential information and related cases or proceedings;
- (iv). including tortious actions related to privacy and publicity rights involving intellectual property issues;
- (v). data exclusivity, domain names and other matters relating to data protection involving intellectual property issues, as also those arising under the Acts as defined in Rule 2(1) including appeals arising out of Sec. 62 of the Information Technology Act, 2000;
- (vi). Including internet violations and any other proceeding pertaining, relating, incidental, ancillary to any of the subject matters under clauses (i) through (v) above.
- (vii). Including any challenge to the order passed under Sec. 11 of the Customs Act,1962 and related notifications

Explanation:

- (i). for the purpose of these Rules, cases pertaining to the Information Technology Act, 2000 dealing with the rights and liabilities of intermediaries, online marketplaces, e-commerce platforms involving issues relating to any of the aforementioned rights, shall be deemed to be within the purview of intellectual property rights.;
 - (ii). intermediaries, online marketplaces, e-commerce platforms shall have the same meaning as under Section 2(w) of the Information Technology Act, 2000.
 - (iii). *For avoidance of any doubt, it is hereby clarified that these rules do not apply to criminal proceedings arising out of the penal provisions under the Acts(s).*
- (8). "**Intellectual Property Rights Division (IPD)**" refers to the division in the Madras High Court presided over by a Single Judge(s) or a Division Bench as the case may be to deal with disputes and cases concerning IPR cases or proceedings, as stipulated under Rule 10 below.

(9). "Intellectual Property Office (IPO)" shall mean –

- (i). in case of Trademarks – Office of 'Registrar of Trademarks';
- (ii). in case of Copyrights – Office of 'Registrar of Copyrights';
- (iii). in case of Patents - Office of 'Controller General of Patents, Designs and Trade Marks';
- (iv). in case of Geographical indications—Office of 'Registrar of Geographical Indications';
- (v). in case of Semiconductor integrated circuits layout-designs – Office of the 'Registrar of the Semiconductor Integrated Circuits Layout-Design';
- (vi). in case of Designs – Office of 'Controller General of Patents, Designs and Trade Marks'.

(10). "IPR cases or proceedings" shall include IPR disputes in the nature of all original proceedings, appellate and other proceedings under the Acts mentioned in Rule 2(1) above, nomenclature of which is as described in Schedule I, filed before or transferred to the IPD including:

- (i). Civil suits and applications therein;
- (ii). Original Applications;
- (iii). Original Petitions;

Explanation: "Original Petitions" include revocation or cancellation, or other original proceedings as prescribed under the Act(s) and "Original Applications" includes arbitration proceedings relating to the subject matters under the Act(s)

- (iv). Writ Petitions (Civil) including those filed against orders or decisions of IPO's which do not have express appeal provisions in the said Act(s), and other authorities such as Customs (acting under Section 11 of the Customs Act, 1962 and the related notifications)

Explanation: Writ Petitions for the purposes of these Rules would not include those that challenge *vires* of any of the provisions of the Act(s) and those which are in the nature of Public Interest Litigation challenging practice or procedure of the IPO's;

- (v). Appeals and petitions from the various IPOs and
- (vi). Such other proceedings which were hitherto maintainable before the Intellectual Property Appellate Board ("IPAB") under provisions of the Act(s) and the Commercial Courts Act, 2015.
- (vii). All pending proceedings before the IPAB as transferred to the Madras High Court.
- (viii). All proceedings before the Madras High Court filed under any nomenclature including Original Petition (OP) or Civil Miscellaneous Appeal (CMA) or Writ Petition (WP) challenging orders or decisions of IPO's or IPAB, prior to establishment of this IPD and before or after abolishment of IPAB

Rule 3 : Extent of Application- These Rules shall govern and apply to all IPR cases or proceedings before the IPD of the Madras High Court.

Rule 4: Jurisdiction - Every IPR case or proceeding filed before, or transferred to, the IPD shall be heard and decided by a Single Judge of the IPD except those that are to be decided by a Division Bench including those proceedings as per Section 13 of the Commercial Courts Act, 2015.

Rule 5 : Procedure for Suits: All Civil suits pertaining to IPR cases or proceedings under these IPD rules shall be governed by the procedure prescribed under the Original Side Rules, 1994 read with High Court Fee Rules, 1956, as amended from time to time, and Civil Procedure Code, 1908 as amended by the Commercial Courts Act, 2015 for such IPR Disputes listed under Section 2 (1)(c) of Commercial Courts Act, 2015. All other IPR disputes not listed under Section 2 (1)(c) of Commercial Courts Act, 2015 shall be governed by the Civil Procedure Code, 1908 and principles relating to/akin to case management of suits under the Commercial Courts Act, 2015 to the extent there is no consistency with these rules will be applicable.

Rule 6: Procedure for Original Petitions (Civil Original Petition)

- (1). Original petition shall be in the format specified in Form No. 1 of Practice Notes to be issued separately by the High Court and with the fees prescribed under Schedule I hereunder and shall be accompanied by an affidavit stating the detailed facts and grounds in support thereof and shall be verified by the party filing the same in the manner prescribed for verification of pleadings in suits.

- (2). The service of summons by the IPD on the respondents in the Original Petitions may be in the manner prescribed in the Code of Civil Procedure, 1908 and the Madras High Court Original Side Rules, 1994.
- (3). The respondent may file a Counter Statement to the said original petition, along with all documents in support thereof and shall be verified in the same manner as a pleading in the Suit, within 30 days from the service of summons on them or within such other period as the Court may allow on an application made to it, together with proof of service thereof on the petitioner.
- (4). In cases of revocation/cancellation of any IP Rights granted, the respective IPO shall be impleaded as a respondent, and it is open to such respondent to file a counter statement if necessary within the time stipulated under Rule (3) above.
- (5). The parties shall file all relevant records including the relevant correspondence, documents from the respective IPO, wherever applicable in support of the relief sought in the original petition. Averments shall be made in the original petition specifying as to which of the documents filed form part of the record before the IPO.
- (6). If interim orders are sought, an application shall be filed setting out the grounds for such interim order.
- (7). Filing of any further affidavits or pleadings shall be strictly with the leave of the Court.
- (8). In case of an original petition relating to patents, the complete specification of the patent along with different versions/claims, if relevant, as also the relevant forms filed, correspondence and documents before the IPO, shall be filed.
- (9). The Court may direct the parties to submit a statement of admission and denial of documents within such period as fixed by the Court, not exceeding one month, from the date of receiving the Counter statement or when the time for filing the same lapses and is recorded by the Court.
- (10). Framing of issues shall not be compulsory in the original petitions. In revocation/cancellation petitions, the Court may frame issues if deemed necessary.
- (11). The Court shall, as far as possible, ensure that the recording of evidence shall be completed in a time bound manner
- (12). The Court may dispense with the oral examination of parties, upon the consent of all the parties to the proceeding and proceed further based on documentary evidence on record.
- (13). For the purposes of oral and documentary evidence in an Original Petition, the provisions of the Indian Evidence Act, 1872, the Code of Civil Procedure, 1908 as amended by the Commercial Courts Act, 2015 and the Madras High Court Original Side rules, 1994 as may be applicable shall apply.
- (14). The Court may direct consolidation of a suit for infringement or passing off involving an IPR with any other proceeding(s) before it, involving the same IPR at any stage.
- (15). Procedures applicable to original petitions: The provisions of the Commercial Courts Act, 2015, Madras High Court Original Side Rules, 1994 as also the practice notes / directions issued from time to time, to the extent there is no inconsistency with these Rules, shall be applicable to original petitions filed in the IPD.

Rule 7 : Procedure for Appeals

- (1). Appeals under Rule 2(4) of the present rules before the IPD shall be filed as per Form No.2 prescribed in Practice Notes to be issued separately by the High Court, within the period of limitation, as applicable for the respective appeals along with the requisite Court fees as prescribed in Schedule I.
- (2). Appeals shall be accompanied with a synopsis, list of dates, the order impugned along with other details as required in the Form applicable.
- (3). In case any interim orders are being sought for by the parties, an affidavit shall be filed setting out the grounds for the same along with the petition seeking such interim order.
- (4). The Appellant shall disclose the details of any prior litigation pending or disposed between the parties with respect to the subject matter in dispute.

- (5). All pleadings, forms and documents forming part of the record of the proceedings, from the IPO / Commercial court, relating to the decision / order / decree challenged in the appeal, shall accompany the appeal.
- (6). Filing of any further affidavits or pleadings shall be strictly with the leave of the Court.
- (7). No party shall be entitled to produce any additional evidence except with the leave of court.
- (8). In all Appeals, all the parties to the proceedings before the IPO, including the respective IPO shall be impleaded, as Respondents.
- (9). The Provisions of Order XLI Code of Civil Procedure Code, 1908, Limitation Act, 1963, the Madras High Court Appellate Side Rules, Civil Rules of Practice and Circular Order and the practice notes / directions issued by the High Court from time to time, as far they are not inconsistent to these rules shall apply to appeals filed under these Rules.

Rule 8 : Procedure for Writ Petitions

- (1). Writ Petitions filed in the IPD, challenging any orders passed by the IPO / authority, shall consist of a synopsis and list of dates and events, Memorandum of the writ petition including grounds of challenge, whether any other remedy was availed of in respect of the same impugned order and if so, provide details thereof including any order passed therein and the prayers/ reliefs sought.
- (2). The impugned order shall be annexed with the writ petition.
- (3). In case any interim orders are being sought for by the parties, an affidavit shall be filed setting out the grounds for the same along with the petition seeking such interim order.
- (4). Procedures applicable to Writ Petitions: The Madras High Court Writ Rules, 2021 and the practice notes / directions issued from time to time, to the extent there is no inconsistency with these Rules, shall be applicable to writ petitions filed in the IPD.

Rule 9 : Procedure for Civil Revision Petition

- (1). All rules applicable to appeals as in Rule 7 above shall apply, *mutatis mutandis* to the revision petitions filed before the IPD.
- (2). Civil Revision Petitions shall be governed by The Madras High Court Appellate Side Rules and Orders/ Practice directions.
- (3). Revision Petitions shall consist of the grounds of challenge, list of dates and events and the order impugned therein.
- (4). In case any interim orders are being sought for by the parties, an affidavit shall be filed setting out the grounds for the same along with the petition seeking such interim order.

Rule 10 : Fees

- (1). The fees payable for proceedings under these Rules shall be as provided under Schedule I.
- (2). The process fees and other incidental charges payable in respect of the preparation and issue of notice shall be borne by the party(ies) concerned.

Rule 11 : General Rules:

- (1). All appeals except those under S.13 (1-A) of the Commercial Courts Act, 2015, original petitions, writ petitions and revisions shall be listed before a Single Judge of the IPD unless otherwise directed to be posted before the Division Bench.
- (2). Every proceeding shall also state the appropriate IPO branch office, as necessary.
- (3). In every proceeding by the Court under Section 57(4) of the Trademarks Act of 1999, the Court shall effect notice under Rule 100 of Trademarks Rules 2017.
- (4). Any order of the High Court in any IPR cases or proceedings involving any proceedings before the IPO, shall be served upon the IPO concerned and the said IPO shall cause such changes to the entry(ies) in the respective Register or proceed in the matter as directed therein.

- (5). An IPR Holder may obtain a certificate of validity by filing an application or a Civil Miscellaneous Petition, as the case may be in the same proceeding wherein the decision of the Court referred to in Section 141 of Trademarks Act and Section 113 of Patents Act was given.

Rule 12: Recording of Evidence

If in the opinion of the Court it is expedient to do so, the Court may direct:

- (1). The recording of evidence through video conference as per the Madras High Court Video Conferencing in Courts Rules, 2020;
- (2). The recording of evidence at any venue outside the premises of the Court;
- (3). The recording of evidence by a Local Commissioner;
- (4). The use of videography and transcription technology or any other form of recording evidence.

Rule 13: Expert Opinion and Evidence

- (1) The IPD may, upon an application by the parties to the proceedings, or upon its own motion, seek assistance or opinion of any person(s) with special knowledge and skills on the subject matter of the IPR case or proceedings pending before it, who may be referred to as Expert(s), subject to clearance of conflict of interest, a panel of which the IPD may maintain and review from time to time.
- (2) The opinion of such Expert(s) shall be recorded in writing and may be considered by the IPD.
- (3) The party whose interest the evidence of the said Expert(s) is adverse to, shall be permitted to be cross-examine such expert(s).
- (4) The Court may adopt such procedure to receive the evidence from multiple Expert(s) as it deems fit, including examining such expert(s) simultaneously.

Rule 14: Consolidation of matters or cases or proceedings or disputes

- (1). Where there are multiple proceedings relating to the same or related IPR, irrespective of whether the said proceedings are between the same parties or not, the IPD may such expert(s) on its own motion or on an application of any other parties, and after hearing such of them as desired to be heard, wherever appropriate, to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/ common trial and consolidated adjudication.
- (2). If the Court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself.

Rule 15: General Clause

Procedures not specifically provided for in these Rules shall, in general, be governed by The Civil Procedure Code, 1908, The Commercial Courts Act, 2015 and the Madras High Court Original Side Rules, 1994, Madras High Court Appellate Side Rules, 1965 and Civil Rules of Practice and Circular Orders, and Practice notes / directions issued by the High Court from time to time, wherever any of these rules are applicable, as far they are not inconsistent to these IPD rules.

Rule 16: Power to remove difficulties

1. If any difficulty arises in giving effect to the provisions of these Rules, the IPD may, by order, make such provision not inconsistent with these Rules as may appear to be necessary or expedient for removing the difficulty.
2. *The High Court may issue such practice notes / directions from time to time for the implementation of these rules, including amendments to or withdrawal of any of the Rules herein.*

Rule 17: Cases transferred from the IPAB

All cases under various categories received in the Madras High Court from the IPAB shall be renumbered, given the nomenclature as provided for in these Rules in Schedule I and listed before the IPD without any fresh or additional court fees to be levied.

SCHEDULE-I

S. No.	Act	Section under which filed	Nature of proceeding	Nomenclature in HIGH COURT	Court Fees Payable
1)	Trademarks	Sec.47: Removal from Register and imposition of limitations on ground of non-use	Original	OP (TM) IPD	Rs.10,000/-
2)	Trademarks	Sec.57: Power to Cancel or vary registration and to rectify the register.	Original	OP (TM) IPD	Rs.10,000/-
3)	Trademarks	Sec. 91. Appeal against order of the Registrar of Trademarks	Appellate	CMA (TM) IPD	Rs.10,000/-
4)	Copyrights	Sec. 19A Petition relating to assignment of Copyright	Original	OP (CR) IPD	Rs.5000/-
5)	Copyrights	Sec. 19A, 23,31,31A,31B, 31C,31-D, 32 and 33A. per Section 31-Statutory license for broadcasting of literary and musical works and sound recording etc.	Original	OP (CR) IPD	Rs.10,000/-
6)	Copyrights	Sec. 50. Rectification of Register by Appellate Board/IPAB	Original	OP (CR) IPD	Rs.10,000/-
7)	Copyrights	Sec. 72. Appeal against orders of Registrar of Copyrights	Appellate	CMA (CR) IPD	Rs.5000/-
8)	Patents	Sec. 64 Revocation of Patents by the Appellate Board/IPAB	Original	OP (PT) IPD	Rs.10,000/-
9)	Patents	Sec. 71. Rectification of Register by Appellate Board/IPAB (Now HC)	Original	OP (PT) IPD	Rs.10,000/-
10)	Patents	Sec. 117-A. Appeals to the Appellate Board from the order of the Controller or Central Government.	Appellate	CMA (PT) IPD	Rs.10,000/-
11)	Geographical Indications	Sec. 27. Power to cancel or vary registration and to rectify the register. Application for rectification of the register by cancelling, expunging or varying of any entry.	Original	OP (GI) IPD	Rs.5000/-
12)	Geographical Indications	Sec. 31. Appeals to the Appellate Board (now HC) from the order of the Registrar.	Appellate	CMA (GI) IPD	Rs.5000/-
13)	Protection of Plants Varieties and Farmers Right Act	56. Appeal against orders or decision of Authority or Registrar relating to registration, claim for benefit sharing, revocation of compulsory licence etc.	Appellate	CMA (PV) IPD	Rs.5000/-
14)	Commercial Courts Act, 2015 from the Commercial Courts	Under Sec.13 (1-A) of the Commercial Courts Act, 2015 from the Commercial Courts as constituted by Sec.3 of Commercial Courts Act,2015	Appellate	CMA-IPD	Rs.2000/-
15)	Commercial Courts Act, 2015 from the Commercial Courts	Under Sec.13(1-A) of the Commercial Courts Act, 2015 from the Commercial Division as constituted by Sec.4 of Commercial Courts Act, 2015	Appellate	OSA-CAD-IPD	As per the Tamil Nadu Court-fees and Suits Valuation Act, 1955 (Tamil Nadu Act XIV of 1955)

S. No.	Act	Section under which filed	Nature of proceeding	Nomenclature in HIGH COURT	Court Fees Payable
	IPR Suits under Section 2 (1)(C) of commercial court 2015			CS-COMM DIV-IPD	As per the Tamil Nadu Court-fees and Suits Valuation Act, 1955 (Tamil Nadu Act XIV of 1955)
	IPR Suits for those not listed in Section 2(1)(C) of commercial court 2015			CS-IPD	As per the Tamil Nadu Court-fees and Suits Valuation Act, 1955 (Tamil Nadu Act XIV of 1955)
	WP for IPR			WP-IPD	As per the Tamil Nadu Court-fees and Suits Valuation Act, 1955 (Tamil Nadu Act XIV of 1955)

Note: The Rule 10(1) and Schedule I shall come into force from the date the necessary amendment(s) to the Tamil Nadu Court Fees and Suit Valuation Act, 1955 are given effect to by the Government of Tamil Nadu.

High Court, Madras,
23rd March 2023.

P. DHANABAL,
Registrar General.